

## REMARKS

In the Office Action mailed July 1, 2004 the Examiner noted that claims 1-16 were pending, and rejected claims 1-16. Claims 1, 2, 9, 12 and 14-16 have been amended, and, thus, in view of the forgoing claims 1-16 remain pending for reconsideration which is requested. No new matter has been added. The Examiner's rejections are traversed below.

In the Office Action the Examiner rejected claims 2, 8, 9 and 12 under 35 U.S.C. §112 paragraph 2 as indefinite. The text of concern to the Examiner with respect to claim 8 is discussed on page 13+ with respect to figures 3 and 4. It is submitted that the text of concern in claim 8 would not be indefinite to a person of skill in the art reviewing the portion of the application noted above. Similarly the phrase at issue in claim 9 is discussed on page 11 of the application specification. It is submitted that the text of concern in claim 9 would not be indefinite to a person of skill in the art reviewing the portion of the application noted above. Claims 2 and 12 have been amended in consideration of the Examiner's comments and it is submitted they satisfy the requirements of the statute. If additional concerns with the claims arise, the Examiner is invited to telephone to resolve the same. Suggestions by the Examiner are also welcome. Withdrawal of the rejection is requested.

In the Office Action the Examiner rejected claims 1-16 under 35 U.S.C. § 112 paragraph 2 as ambiguous alleging that an apparatus and a process are being combined (".. the claims claiming an apparatus and a process..."), particularly noting claim 1. The Examiner has provided no comments or a basis for this rejection, that is, has not provided comments concerning a reason or a line of thinking as to why this rejection is being made. This rejection is traversed. The Examiner is requested to clarify this rejection and provide comments describing his line of reasoning. Claim 16 is a means plus function claim specifically statutorily authorized by 35 USC § 112, paragraph 6. Claim 15 is a method claim in which no apparatus limitations are recited. Claim 14 is a product or manufacture claim under 35 USC § 101 and is specifically discussed as a statutory type of claim in MPEP § 2106 IV 2 (a). Claim 1 (and dependent claims 2-13) recite an apparatus performing operations not process steps, an entirely proper claim recitation. It is submitted that the claims are not ambiguous and withdrawal of the rejection is requested.

On page 6 of the Action the Examiner rejected claims 1-16 under 35 USC § 101 for essentially the same reason alleging that overlapping statutory classes are being claimed. For the reasons discussed above, it is submitted that the claims are not directed to overlapping statutory classes.

Additionally, with respect to the rejections under § 112 for ambiguousness and under § 101 for overlapping statutory subject matter, the undersigned specifically discussed claims 1 and 14-16 with SPE Teska by telephone on September 30, 2004. SPE Teska indicated that the claims did not appear to mix statutory classes. For this further reason, withdrawal of the rejection is requested.

On page 6 of the Office Action, the Examiner rejected all claims under 35 U.S.C. § 102 as anticipated by Ji. The Examiner has particularly noted the abstract and pages 265, 266, 270, 273-277, 286-293, 296, 297, 301-303 and 305 of Ji and compared these parts to the claims of the present invention and the teachings of the specification.

The Examiner appears to be making general comparisons. For example, the Examiner appears to compare the amendment list of the present invention with the dependency graph of Ji discussed on page 305. It is noted that we previously argued that Ji did not provide an amendment list and this argument is again reasserted. A dependency graph is not an amendment list.

Ji does not describe the machine interpretation systems in detail but rather describes operations and structures in a general way. Our review of Ji, particularly the parts noted by the Examiner, indicates that Ji does not describe the details of the present invention. For example, the present invention calls for detecting redundant shapes by "comparing shape coordinates" and then generating a list of deletions and amendments "responsive to the coordinate based comparison" (see claims 1 and 14-16). This detection operation is particularly described on specification pages 18 - 20 that discuss flowchart figures 11 and 12. For example, page 18 starts by describing the comparison (S4) of vertex coordinates of an attribute or shape to add an attribute to a deletion list and page 20 ends by discussing the comparison (S10) of the sectional shape to the shape of the arrangement plane to determine a deletion list candidate. Ji does not discuss such details of a detection operation and nor are they suggested by Ji.

It is submitted that the present claimed invention patentably distinguishes over Ji and withdrawal of the rejection is requested.

It is submitted that the claims satisfy the requirements of 35 U.S.C. § 112 and 101. It is further submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

Serial No. 09/731,799

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

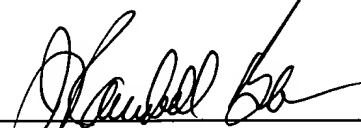
Respectfully submitted,

STAAS & HALSEY LLP

Date: \_\_\_\_\_

10/1/4

By: \_\_\_\_\_



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